

REMARKS

In the office action mailed February 14, 2005, Claims 1-8 stand rejected under 35 U.S.C.

§ 103(a) as being allegedly unpatentable over U.S. Patent No. 6,185,184 (Mattaway) in view of U.S. Patent No. 6,891,837 (Hipp). In the office action, the Examiner considered the declaration filed on November 21, 2005 under 37 C.F.R. 1.131 “ineffective to overcome the 35 U.S.C. 103(a) rejection utilizing Hipp et al.” The Examiner asserted that “the evidence submitted is insufficient to establish diligence from a date prior to 05 October 1999 of the Hipp reference to 24 February 2000 the effective filing date of the application.”

Throughout the office action the Examiner cited a variety of case law to assert that Applicants “must show evidence of facts establishing diligence” and “diligence must be judged on the basis of particular facts in each case.” Further, the Examiner also cited 37 CFR 1.131 in describing the critical time period of diligence: “the critical period in which diligence must be shown begins just prior to the effective date of the reference or activity and ends with the date of a reduction to practice, either actual or constructive.”

Without conceding any of the Examiner’s rejections or comments not particularly addressed, Applicants have “submitted evidence of facts establishing diligence” and “particular facts” related to Applicants’ presently pending application. In particular, Applicants’ further submit that the “diligence of attorney in preparing and filing patent application inures to the benefit of the inventor.” (MPEP 2138.06)

To make an even stronger showing of diligence, Applicants have enclosed three redacted correspondences from Applicants’ representative to Applicants’ Assignee to show diligence just prior to the effective date of the Hipp reference ending with at least a constructive reduction to practice as of the filing date of February 24, 2000. The first correspondence, dated July 30,

1999, confirms receipt of a disclosure submitted by Applicants (Tab A). The second correspondence, dated September 1, 1999, contains instructions from Applicants' representative recommending Applicants' Assignee to file an application of the submitted disclosure (Tab B). The third correspondence, dated January 14, 2000, includes references to an assignment, a declaration and power of attorney, and an application, all of which were prepared by Applicants' representative (Tab C).

The second correspondence supports a time period of diligence from at least September 1, 1999, which is just prior to the earliest purported priority date of Hipp (October 5, 1999), to at least a constructive reduction to practice as of the filing on February 24, 2000. Moreover, the third correspondence provides supporting evidence that Applicants' representative was diligent in preparing the application.

MPEP 2138.06 includes *Bey v. Kollonitsch*, 866 F.2d 1024, 231 USPQ 967 (Fed. Cir. 1986), which concludes:

Reasonable diligence is all that is required of the attorney. Reasonable diligence is established if attorney worked reasonably hard on the application during the continuous critical period. If the attorney has a reasonable backlog of unrelated cases which he takes up in chronological order and carries out expeditiously, that is sufficient. Work on a related case(s) that contributed substantially to the ultimate preparation of an application can be credited as diligence.

Applicants submit that the time period from the second correspondence to the filing date, a time period of less than 6 months, cannot be construed as lacking diligence. Given the technical complexity of the subject matter of the application and the length of the disclosure, this time period is not unreasonable. In contrast to a less complex field, such as a mechanical device, the field of the Applicants' application is related to communication in data networks and a method and an application programming interface for assigning multiple network addresses.

(Spec., pg. 2, lines 3-5). In order to accurately prepare Applicants' detailed application, a sufficient amount of time is necessary to adequately convey and enable all of the technical details relating to the application.

Moreover, Applicants' application is 45 pages in length and the application also includes supporting figures. Couple this with the fact that during the drafting of an application a variety of factors affect the amount of time it takes to draft an application. For instance, an attorney or agent may need to review pertinent technical information in order to properly enable an application; various inventor conferences may be conducted in order to clarify certain details that will be included in the application; or, draft applications may need to be revised and edited numerous times before the application accurately represents the invention before it is filed. Bearing in mind the complexity of the field and the detailed, lengthy submitted disclosure, the time period from September 1, 1999 to February 24, 2000 is not unreasonable. Thus, this time period cannot be interpreted to lack diligence. Accordingly, all rejection of pending claims 1-8 over the Hipp reference should be withdrawn.

Conclusion

For at least the reasons set forth above, Applicants submit that claims 1-8 are in condition for allowance and respectfully request the Examiner to pass this application to issue. Applicants' representative has attempted to discuss the relevant facts pertaining to the case via a telephone interview. Applicants' representative have yet to receive the scheduled returned phone call regarding the 1.131 affidavit, however, if, in the opinion of the Examiner, a telephone conference would expedite the prosecution of this application, the Examiner is invited to call the undersigned representative at 312-913-3332.

Respectfully submitted,

McDonnell Boehnen Hulbert & Berghoff LLP

Date: 4/14/2006

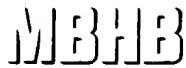
By:



~~John G. Tolomei
Reg. No. 57,846~~

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July 30, 1999

PRIVILEGED AND CONFIDENTIAL

Mr. Michael S. Borella
3Com Corporation
1800 West Central Road
Mt. Prospect, IL 60056

Mr. Nurettin B Beser
3Com Corporation
3800 Golf Road
M/S RM.105
Rolling Meadows, IL 60008

Re: **U.S. Patent Application**
"Per Application Virtual Interface Support for TCP/IP"
Inventors: Michael S. Borella and Nurettin B. Beser
MBHB Case No. 99,447
3Com Docket No. 2459.CS.US.P

Gentlemen:

This is to inform you that your disclosure has been received by our law firm and that we will be preparing a patent application for the above-identified invention.

Unless otherwise instructed, I will be contacting Mr. Borella with more detailed questions regarding your invention in the coming weeks. Please feel free to call me if you have any questions or comments about the patent application process. I can also be reached by 3Com's e-mail system.

Sincerely,

A handwritten signature in black ink, appearing to read "Marcus J. Thymian".

Marcus J. Thymian

MJT/cfa

c: Patti Contreras
Holly Mueller
Bradley J. Hulbert

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September 1, 1999

PRIVILEGED AND CONFIDENTIAL

Via Facsimile

William G. Becker, Esq.
Legal Director - Patent Program
3Com Corporation
5400 Bayfront Plaza
Santa Clara, CA 95052

Re: Invention Disclosures

REDACTED

“Per Application Virtual Interface Support
for TCP/IP”
Inventors: Michael S. Borella, Nurettin B. Beser
MBHB Case No. 99,447
3Com Docket No. 2459.CS.US.P

Dear Bill:

Upon review of the above-referenced disclosures, it is our recommendation that 3Com docket number 2459.CS.US.P be filed before the remaining four applications.

REDACTED

William G. Becker, Esq.

September 1, 1999

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If you have any questions regarding any of the above, please do not hesitate to contact me.

Very truly yours,

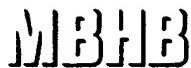

Bradley J. Hulbert

BJH:hm

c: Steven F. Borsand, Esq.
 Malcolm J. Duncan, Esq.

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January 14, 2000

Via Federal Express

Michael S. Borella
3Com Corporation
1800 West Central Road
Mt. Prospect, IL 60056

Re: U.S. Patent Application
*"Application Programming Interface for Assigning
Multiple Network Addresses"*
Relevant Personnel: Michael S. Borella and Nurettin B. Beser
MBHB Case No. 99,447
3Com Docket No. 2459.CS.US.P

Dear Mike:

Enclosed please find: 1) an Assignment, and 2) a Declaration and Power of Attorney for the above referenced application.

Once we agree that we have reached a final draft for this application, both you and Burcak should sign the documents and return them to me. The Assignment must be signed in the presence of a Notary and notarized.

Sincerely,

A handwritten signature in black ink that appears to read "Malcolm Duncan".

Malcolm Duncan

MJD:bam
Enclosure

cc: Patti Contreras (w/o encl.)
Bradley J. Hulbert (w/o encl.)